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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/379,540	08/24/1999	SHLOMO BEN HAIM	BIO-76	1397

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AUDLEY A CIAMPORCERO JR
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 089337003

EXAMINER	
MAIORINO, ROZ	
ART UNIT	PAPER NUMBER
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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 21

Application Number: 09/379,540
Filing Date: August 24, 1999
Appellant(s): HAIM ET AL.

Louis J. Capezzuto
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10-6-2003

1. A statement identifying the real party in interest is contained in the brief.

2. A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

3. The statement of the status of the claims contained in the brief is correct.

This appeal involves claims 1-40.

4. No amendment after final has been filed.

5. The summary of invention contained in the brief is correct.

6. The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: the first issue stated by the applicant stating he has filed a terminal disclaimer is not correct. Applicant has not officially filed a terminal disclaimer, he has only provided the office with a copy of a terminal disclaimer. Applicant must officially provide the office with a terminal disclaimer and pay the proper fees.

7. The rejection of claims 1-40 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

8. A substantially correct copy of appealed claims 1-40 appears on page 13-16 of the Appendix to the appellant's brief. The minor errors are as follows: claim 10 on page 14 of the appeal brief states " The method according to claim 9, including determining a delivery site at said." According to the last amendment in paper NO.16 claim 10 should read as "The method according to claim 9, including determining a delivery site at said infarct region."

9.

6258789	GERMAN ET AL	7-2001
6283951	FLAHERTY ET AL	9-2001
6321109 B2	BEN-HAIM ET AL.	11-2001
6027473	PONZI	2-2000

10. Claims 1-18, 25-40 rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 17.

Claims 1-18, 25-40 rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 17

Claims 19-24 rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 17.

Claim 1 rejected under the judicially created doctrine of double patenting over claim 1 of U. S. Patent No. 60309370 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

11. The appeal brief filed under 37 CFR 1.132 filed 10-14-2003 is insufficient to overcome the rejection of claims 1-40 based upon US Patent No. 6309370 to Ben-Haim in view of US Patent No. 6283951 Flaherty et al as set forth in the last Office action because: the applicant has alleged that Ben-Haim is exempt as a 103 rejection based on 103(c), and since the applicant and Ben-Haim have the same assignee as the applicant the reference is unavailable as prior art. This allegation is incorrect, because the applicant's US filing date is August 24, 1999 and dates back to a CIP filed on February 5,1998. Both of which are prior to November 19, 1999. MPEP 706.02(1) states "*Prior* to November 29, 1999, 35 U.S.C. 103(c) provided that subject matter developed

by another which qualifies as "prior art" only under subsections 35 U.S.C.102(f) or 35 U.S.C. 102(g) is not to be considered when determining whether an invention sought to be patented is obvious under 35 U.S.C. 103, provided the subject matter and the claimed invention were commonly owned at the time the invention was made. See MPEP § 706.02(l)(1) for information regarding when prior art under 35 U.S.C. 102(e)/103 is disqualified under 35 U.S.C. 103(c).

For applications filed *prior* to November 29, 1999, the subject matter that is disqualified as prior art under 35 U.S.C. 103(c) is strictly limited to subject matter that A) qualifies as prior art only under 35 U.S.C. 102(f) or 35 U.S.C. 102(g), and B) was commonly owned with the claimed invention at the time the invention was made. If the subject matter that qualifies as prior art only under 35 U.S.C. 102(f) or 35 U.S.C. 102(g) was not commonly owned at the time of the invention, the subject matter is not disqualified as prior art under 35 U.S.C. 103(c)." (emphasis added). Since the current applicants applicant was filed prior to November 29, 1999 Ben-Haim is available as prior art and applicable under 103.

Furthermore the rejection is under 35 U.S.C. 103(a) and the applicant has assumed Ben-Haim was applied as a 102(e) prior art, however Ben-Haim is also be available as a 102(a) prior art thereby still providing a proper bases for a 35 U.S.C. 103(a) rejection.

Alternatively, the Applicant has argued Ben-Haim does not teach angiogenesis or myogenesis. However Ben-Haim was used as a 35 U.S.C. 103(a) in combination with

US Patent No. 6283951 Flaherty, and Flaherty does teach angiogenesis in Col.1, lines 10-15 as stated in last office action in Paper NO.17.

Applicant's third argument is address towards Flaherty, and its lack of teaching an "orientation element" or "a marker that may be imaged using an external imaging system". However as stated earlier this rejection is a 35 U.S.C. 103(a) and as stated in the final office action in Paper No.17, the orientation element and marker that may use an external imagining system is taught by Ben-Haim in Col. 5, lines 45-60, and Col.10, lines 5-15.

12. The appeal brief filed under 37 CFR 1.132 filed 10-14-2003 is insufficient to overcome the rejection of claims 1-40 based upon US Patent No. 6027473 to Ponzi in view of US Patent No. 6283951 Flaherty et al as set forth in the last Office action because: the applicant has repeated his argument regarding 103(c) , and how Ponzi is assumed to be used as a 102(e) in a 35 U.S.C. 103(a) rejection. And because the applicant and Ponzi share the same assignee Ponzi cannot be used to reject the applicant's claims. However as stated above according to MPEP 706.02(1) "For applications filed *prior* to November 29, 1999, the subject matter that is disqualified as prior art under 35 U.S.C. 103(c) is strictly limited to subject matter that A) qualifies as prior art only under 35 U.S.C. 102(f) or 35 U.S.C. 102(g), and B) was commonly owned with the claimed invention at the time the invention was made. If the subject matter that qualifies as prior art only under 35 U.S.C. 102(f) or 35 U.S.C. 102(g) was not commonly owned at the time of the invention, the subject matter is not disqualified as prior art under 35 U.S.C. 103(c)." (Emphasis added)

13. The appeal brief filed under 37 CFR 1.132 filed 10-14-2003 is insufficient to overcome the rejection of claims 1-40 based upon US Patent No. 6321109 to Ben-Haim in view of US Patent No. 6283951 Flaherty et al and further in view of US Patent No.6258789 to German et al as set forth in the last Office action because: applicant alleges German fails to teach utilizing a genetically superior cell, utilizing an immunosuppressant, treating the cell prior to delivery, harvesting the cell from the patient, utilizing a cell that is xenograft. However as stated in the final office action in Paper No.17, German teaches a genetically superior cell, and treatment of cell prior to delivery in Col.3, lines 34-40. Applicant alleges that the word "superior" has not been used in German, however German does teach a method of production of genetically transformed intestinal epithelial cell, such a cell has obviously been treated and maybe referred to as a superior intestinal epithelial cell, furthermore German teaches the intestinal cell to be harvested from a mammalian subject which may include both the patient or xenograft. (Abstract). German furthermore stated in Col. 2, lines 53-60, that exposure of DNA and any carrier associated with it to the immune system, will result in adverse reaction, such as an anaphylaxis reaction. Therefore it would be obvious to utilize some type of an immunosuppressant to prevent such a devastating reaction. Such practice is very commonly seen in patient who are going through a transplant, due to potentially deadly side effects of graft-versus-host disease the treating physician always utilizes some type of immunosuppressant. (Medical Diagnosis & Treatment, Lawrence Tierney, Stephen McPhee, and Maxine Papadake, 38th edition, 1999, pages

773-775). The Medical Diagnosis & Treatment reference is only cited here as further evidence in support of what was already asserted in Office Action in Paper NO.17. Office Action in Paper NO. 17 states" Any exposure of the DNA of the treated cell to the immune system can result in adverse reaction such as inflammatory reaction to the DNA administered. Therefore it would be beneficial to treat these cells with immunosuppressants prior to implantation." page 6 lines 12-17.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

RM
February 20, 2004

Conferees
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BRIAN L. CASLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700

AUDLEY A CIAMPORCERO JR
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 8933-7003

ANGELA D. SYKES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700